

The opinion in support of the decision being entered today was **not** written
for publication and is **not** binding precedent of the Board.

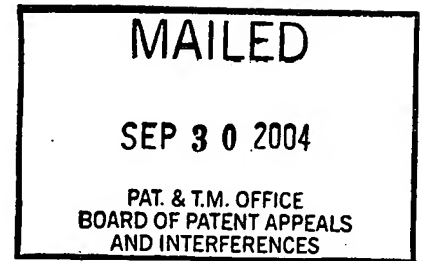
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL COFFIN, ROBERT L. MUELLER
and MORLEY C. TOBEY, JR.

Appeal No. 2004-2161
Application No. 10/028,875

ON BRIEF



Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 5-8
and 14-23. Claims 3 and 4 have been canceled and claims 9-13 have been withdrawn
from consideration.

We AFFIRM.

BACKGROUND

The appellants' invention relates to an assembly for limiting the movement of one body with respect to another. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Beals <u>et al.</u> (Beals)	5,433,516	Jul. 18, 1995
Greenheck <u>et al.</u> (Greenheck)	6,547,289 B1	Apr. 15, 2003
		(filed Nov. 8, 2000)

Claims 1, 2, 5-8, 14 and 17-23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Beals.

Claims 15 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Beals in view of Greenheck.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (mailed Dec. 16, 2003) and the final rejection (mailed July 31, 2003) for the examiner's reasoning in support of the rejections, and to the Brief (received Oct. 31, 2003) and Reply Brief (received Feb. 9, 2004) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The Rejection Under Section 102

The first of the examiner's rejections is that claim 1, the sole independent claim, and dependent claims 2, 5-8, 14 and 17-23, are anticipated¹ by Beals. The only argument in the Brief in response to this rejection is that Beals does not disclose or teach all of the subject matter recited in claim 1 because, contrary to the examiner's position, in the Beals device first section 190 of bendable piece 180 is not "attached to" second body 170 by means of its contact with transverse bar portion 192 when first body 160 is moved with respect to the second body.

¹Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See Verdegaal Brothers Inc. v. Union Oil Co. of California, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). Nor does it require that the reference teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

In the Reply Brief, the appellants additionally argue that first section 190 is not "attached to" second body 170 by virtue of end 182, which snaps over transverse bar portion 183 of second body 170, as is pointed out by the examiner on page 4 of the Answer. However, in this case we do not agree with the appellants.

In accordance with the common definition of the term, which was provided by the appellants on page 7 of the Brief, "attached" means fastened, secured, or joined to another object. In the Beals arrangement shown in Figures 24 and 24A, piece 180 comprises integrally formed sections 182, 186, 188 and 190. Section 182 of piece 180 clearly is directly attached to second body 170 by virtue of being snapped into an opening in transverse bar 183 (column 9, line 34 et seq.). Sections 186 and 188, along with section 190, which the examiner has found to be the claimed "first section," are integral with portion 182, and therefore it is our view that they also are "attached to" second body 170, albeit not directly. Claim 1 is cast in "comprising" format,² as well as not requiring that the first section of the bendable piece of material be directly attached to the second body. It is our opinion that section 190 of Beals thus meets the "attached to" limitation of the claim. We are not persuaded otherwise by the appellants' argument that this is an inappropriate definition of "attached," which appears to be based upon

²It is well settled the use of the term "comprising" in a claim opens the claim to inclusion of elements or steps other than those recited in the claim. See, for example, In re Hunter, 288 F.2d 930, 932, 129 USPQ 225, 226 (CCPA 1961).

the premise that claim 1 requires the first section to be directly attached to the second body (Reply Brief, page 2). It is true that in the embodiment of the invention disclosed by the appellants in their application the first section of the bendable piece of material is attached directly to the second body. However, during examination before the Patent and Trademark Office, the pending claims in an application must be interpreted as broadly as their terms reasonably allow, without reading any limitations from the specification into the claims, for during prosecution, when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed. See In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). If the limitations in the specification were required to be read into the claims there would be no need for claims and no basis for the requirement of 35 U.S.C. §112 that the specification conclude with claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. Sjolund v. Musland, 847 F.2d 1573, 1580, 6 USPQ2d 2020, 227 (Fed. Cir. 1988).

The appellants' arguments not being persuasive, it is our conclusion that claim 1 reads on the apparatus disclosed in Figures 24 and 24A of Beals, and therefore the reference anticipates the claim. The rejection of claim 1 is sustained.

This rejection applies not only to claim 1, but to claims 2, 5-6, 14 and 17-23, all of which depend from claim 1. The appellants have asserted on pages 4-6 of the Brief that each of these claims is "separately patentable" from the other claims in the group,

and have with regard to each claim recited the element each of these claims adds to the claim from which it depends. However, while the appellants have made a statement that the claims do not stand or fall together, they have not pointed out where the examiner has erred in concluding that these limitations are disclosed or taught by Beals. This being the case, the claims will be grouped with claim 1, from which they depend, and the like rejection of them is sustained. See In re Nielson, 816 F.2d 1567, 1570, 2 USPQ2d 1525, 1526 (Fed. Cir. 1987).

Claim 22 depends from claim 1 through claim 6, which establishes that the bendable piece further comprises a third section contiguous to the second section and oriented at a specific angle thereto. The appellants argue that claim 22 is not anticipated by Beals because applying a force to section 186 of the Beals piece "would result in pushing against a physically unsupported item" (Brief, page 8). This clearly is not the case, for such a force would be transmitted through integral sections 186 and 182 to the second body (170). The rejection of claim 22 is sustained.

We apply analogous reasoning in sustaining the rejection of claim 23, which through claims 8 and 6 adds to claim 1 a fourth section of the bendable piece. The appellants argue here that application of a force to the straight portion of section 184 "would result in little or no motion" (Brief, page 8). We do not agree, for it is clear that application of a force perpendicular to the straight portion of section 184 would cause

movement of sections 186, 188 and 190 to a second position, which is all that is required by the claim. The rejection of claim 23 is sustained.

The Rejection Under Section 103

Dependent claims 15 and 16 stand rejected as being obvious³ in view of the combined teachings of Beals and Greenheck. In this rejection the examiner finds all of the subject matter recited in the two claims to be disclosed or taught by Beals, except for applying the force to the bendable piece of material by means of a tool. However, the examiner takes the position that to do so would have been obvious in view of the teachings of Greenheck because "such an arrangement improves the mechanical advantage" (final rejection, page 5). The only argument raised by the appellants with regard to this rejection is that Beals fails to disclose or teach all of the limitations found in claim 1 and this deficiency is not overcome by Greenheck.

As explained above, it is our view that Beals anticipates the subject matter of claim 1, and considering Beals in the light of Section 103 does not cause us to alter this conclusion. The appellants do not challenge the examiner's combining of Greenheck with Beals in order to meet the terms of claims 15 and 16. We therefore conclude that

³The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

CONCLUSION

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).



Charles E. Frankfort


JEFFREY V. NAGE

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